

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MAY 11, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Orlando Food Corporation
v.
Orlando Baking Co.

Opposition No. 100,996
to application Serial No. 74/571,405
filed on September 9, 1994

Stephen L. Baker of Baker & Friedman for Orlando Food
Corporation.

James V. Tura, Esq. for Orlando Baking Co.

Before Simms, Chapman and McLeod, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Orlando Baking Co. has filed an application to register
the mark shown below

on the Principal Register for "breads, biscuits, cakes,

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pizza, cookies, doughnuts, pastry and confectionery goods, namely confectionery chips for baking."¹

Orlando Food Corporation has opposed registration of the mark alleging that opposer has continuously used ORLANDO as a trademark and trade name, and has used ORLANDO FOOD CORPORATION as a corporate name, both for a wide variety of food products and for food brokerage services, including the importation and distribution of a wide variety of foods and beverages, since long prior to any date which may be claimed by applicant; that opposer owns Registration No. 863,628 for the mark ORLANDO for canned vegetables²; and that applicant's mark, when used in connection with its goods, so resembles opposer's previously used and registered trademark ORLANDO, as to be likely to cause confusion, mistake, or deception.

Applicant admits that Registration No. 1,847,792³ for

¹ Application Serial No. 74/571,405, filed September 9, 1994. The claimed dates of first use and first use in commerce are December 30, 1872 and December 30, 1985, respectively. Applicant disclaimed the words "Baking Co." and "Finest Breads Since 1872."

² Registration No. 863,628, issued January 14, 1969, for "artichoke hearts, canned fish and cheese"; Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed. The claimed date of first use and first use in commerce is 1961.

³ This registration was not pleaded by opposer, but it was mentioned by applicant in its answer. Registration No. 1,847,792, issued under Section 2(f) on August 2, 1994 to opposer, for the mark ORLANDO for "artichoke hearts, canned fish, cheese, processed olives, canned vegetables, tomato paste, canned tomatoes, and roasted peppers" in International Class 29 and "tomato sauce" in International Class 30; Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce for both classes are 1961.

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the mark ORLANDO issued on August 4, 1994 and that opposer is the owner of Registration No. 863,628, but applicant otherwise denies the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the opposed application; the testimony, with exhibits, of Stephen L. Baker, one of opposer's attorneys⁴; opposer's notice of reliance on status and title copies of its Registration Nos. 863,628 and 1,847,792; opposer's six other notices of reliance on materials including photocopies of pages from the Official Gazette, photocopies of third-party registrations, and several articles from the Internet (most including recipes), all offered to show the relatedness of the parties' goods; and the testimony, with exhibits, of Daniel V. Holan, applicant's manager of marketing, advertising and purchasing. Both parties filed briefs on the case. An oral hearing was not requested.

Preliminarily, we note that applicant filed a motion (both as a separate motion and as a section contained within applicant's brief on the case) to strike opposer's testimony of Stephen L. Baker. This motion was denied by Board order dated September 30, 1999.

⁴ Applicant filed a motion to disqualify opposer's attorney. On September 30, 1998 applicant's motion was denied in an opinion by the Chief Administrative Trademark Judge, referencing Patent and Trademark Office Rules 10.62(b)(2) and 10.63(a) relating to matters of formality.

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Opposer filed a motion (as a section contained within its brief on the case) to strike certain exhibits to Daniel V. Holan's testimony. Opposer essentially contends that the involved exhibits are incomplete PTO records and/or are irrelevant. Applicant responded to the motion in its brief on the case, and opposer replied in its reply brief on the case. Opposer's motion to strike is denied.

The Board states for the record that we are aware of both parties' various objections to the minimal record presented in this case. We have considered the evidence before us for whatever probative value it has.

Opposer's proven registrations on the Principal Register constitute prima facie evidence of opposer's use of the mark shown therein for the goods identified in the registrations as of the filing date of the applications which matured into the registrations. See *Johnson Publishing Company, Inc. v. International Development Ltd., Inc.*, 221 USPQ 155 (TTAB 1982); and *Hyde Park Footwear Company, Inc. v. Hampshire-Designers, Inc.*, 197 USPQ 639 (TTAB 1977). Further, the registrations are entitled to the statutory presumptions of Section 7(b) of the Trademark Act, specifically, the validity of the registrations, opposer's ownership of the mark, and opposer's exclusive right to use the mark in connection with the goods recited in the registrations. Thus, in this case opposer is entitled to

the presumption that it has used the mark ORLANDO for "artichoke hearts, canned fish and cheese" since June 5, 1968, and that it has also used that mark for "processed olives, canned vegetables, tomato paste, canned tomatoes, roasted peppers and tomato sauce" since February 25, 1993.

Stephen L. Baker, opposer's attorney, essentially testified that he visited supermarkets in his local area, purchased goods, and later photographed certain of the goods together.

Daniel V. Holan, applicant's manager of marketing, advertising and purchasing, testified that a bakery was originally founded by the Orlando family in Italy in 1872, and in 1904 a branch of the family moved to Cleveland, Ohio, and began selling bread in that year under the mark ORLANDO; that applicant has continuously sold bread and baked goods since that date; that applicant has sold bread under the mark as now applied for since 1984⁵; that applicant's gross sales for baked goods for 1997 were about \$40 million, and its advertising expenditures for the same year were over \$300,000; and that the majority (about 70%) of applicant's sales take place in the state of Ohio.

Because opposer owns valid and subsisting registrations of its pleaded mark, the issue of priority does not arise.

⁵ During cross-examination Daniel V. Holan explained that the statement in the application that the trademark "as shown" was first used "at least as early as December 30, 1872" is incorrect.

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See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995).

The only issue to be determined, therefore, is whether applicant's ORLANDO and design mark, when used in connection with "breads, biscuits, cakes, pizza, cookies, doughnuts, pastry and confectionery goods, namely confectionery chips for baking," is likely to cause confusion as to the origin or affiliation of the parties' goods. Upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), for determining whether a likelihood of confusion exists, we find that confusion is likely.

Turning first to a consideration of the parties' respective goods, it is well settled that goods need not be identical or even competitive to support a finding of likelihood of confusion, it being sufficient instead that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); and *In re International Telephone and Telegraph Corporation*,

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197 USPQ 910 (TTAB 1978). Nor is it necessary that a likelihood of confusion be found as to each item included within applicant's identification of goods. See *Alabama Board of Trustees v. BAMA-Werke Curt Baumann*, 231 USPQ 408, footnote 7 (TTAB 1986).

The complementary nature of applicant's "pizza" and opposer's items such as "tomato sauce," "cheese," "processed olives," "artichoke hearts," and "roasted peppers," all of which can serve as toppings for pizza, is obvious and cannot be ignored. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). Opposer's goods are closely related to at least one of the goods listed in applicant's identification of goods.

Neither parties' goods as identified are restricted in any way as to uses or trade channels or purchasers. In determining the question of likelihood of confusion, the Board is constrained to compare the goods as identified in defendant's application with the goods as identified in plaintiff's registration. See *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983); and *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320 (TTAB 1985).

Applicant's argument that its bakery goods are sold at retail outlets, while opposer's goods are primarily sold to

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wholesale markets is unpersuasive, because there is no restriction to the channels of trade in the involved application or in the registrations. Therefore, the Board must assume that the products move through all the ordinary and normal channels of trade for such goods to all the usual purchasers for such products. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, we are dealing here with relatively inexpensive food products and the average purchaser may exercise less care in the purchasing decision.

In this case, the goods of both parties could be encountered by purchasers in circumstances that would give rise to the belief that both parties' goods come from or are associated with the same source. See *Dan Robbins & Associates, Inc. v. Questor Corporation*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979).

Another du Pont factor to be considered in the case now before us is "the variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark)." Opposer has registered the mark ORLANDO for a variety of food products (all or most of which can be used as toppings for pizza), including canned fish, cheese, vegetables such as artichoke hearts, olives, and roasted peppers, as well as

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canned vegetables, and tomato sauce and tomato paste. Purchasers aware of the variety of opposer's goods sold under the mark ORLANDO may well assume that opposer is now offering pizza and other bakery products under the mark ORLANDO. See *Uncle Ben's Inc. v. Stubenberg International Inc.*, 47 USPQ2d 1310, 1313 (TTAB 1998).

We turn next to a consideration of the marks. It is well settled that marks are considered in their entireties, but in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. See *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). We find the dominant origin-indicating portion of applicant's mark is the word ORLANDO⁶, which is identical to the registered mark. That is, the common significant element in both parties' marks is the same word, ORLANDO. The design feature and the disclaimed wording in applicant's mark do not offer sufficient differences to create a separate and distinct commercial impression. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

⁶ On cross-examination applicant's witness, Daniel V. Holan, was asked if ORLANDO is the dominant feature of applicant's current

Moreover, the word ORLANDO in applicant's mark, i.e., the portion utilized in calling for the goods, is most likely to be impressed in the purchaser's memory and to serve as the indication of origin.⁷ See Consumers Building Marts, Inc. v. Mr. Panel, Inc., 196 USPQ 510 (TTAB 1977).

The differences in the marks may not be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; that is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992); and Edison Brothers Stores v. Brutting E.B. Sport-International, 230 USPQ 530 (TTAB 1986).

Giving appropriate weight to all components of the involved marks, and considering the marks in their entirety, we find that these marks are similar in sound, connotation and commercial impression. See In re Hearst

mark, and he answered "yes, the word Orlando is the dominant element on the logo."

⁷ The disclaimed words "Finest Breads Since 1872" and "BAKING CO." are not origin-indicating words, and would not be a memorable portion of applicant's mark.

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Corp., 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992); and In re National Data Corp., supra.

Even if purchasers specifically realize that there are some differences between the involved marks, they may believe that applicant's mark is simply a revised version of opposer's mark, with both serving to indicate origin in the same source. Opposer's mark has been registered for thirty years, and a purchaser familiar with opposer's goods sold under the registered mark may, upon seeing applicant's mark on the complementary, related goods, assume that applicant's goods come from the same source as opposer's goods.

Applicant's argument that opposer has a weak mark is not substantiated in the record. Applicant's witness, Daniel V. Holan, identified as exhibits a few pages from a telephone directory, and a few pages from the Internet, both listing persons with the surname "Orlando." However, this evidence, by itself, does not establish that ORLANDO is primarily merely a surname, especially in light of opposer's ownership of registrations on the Principal Register. Applicant's witness, Daniel V. Holan, also identified photocopies of several pending application listings, but because they are applications, and they are not for goods in the foods classes, they are not persuasive. Applicant's exhibits of several third-party registrations which include the term ORLANDO consist of opposer's two registrations of

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the mark ORLANDO; the mark ORLANDO MAISON in stylized lettering for beverages (cancelled under Section 8 in 1996); the mark ORLANDO'S CATERERS and design for delicatessen-style prepared items (cancelled under Section 8 in 1992); the mark ORLANDO MAGIC FANATTIC and design for retail licensed and retail mail order catalog services featuring apparel, sporting goods and sporting memorabilia; the mark ORLANDO MAGICARD and design for convention and visitors bureau services promoting business and tourism in the Orlando, Florida area; the mark ORLANDO INFORMATION NETWORK and design for information packages and promoting tourism in and relocation to Orlando, Florida.

First, applicant did not submit any existing third-party registrations of the mark ORLANDO in the relevant field, especially bakery items and/or various vegetables, canned vegetables, tomato sauce, etc. In any event, third-party registrations are not evidence of third-party use or that the purchasing public is aware of these marks. The evidence of record is not convincing that opposer's mark is a weak mark in its field.⁸

Even if applicant had proven that opposer's mark is weak, such marks are still entitled to protection against registration by a subsequent user of the same or similar

⁸ Conversely, opposer's argument that its mark is a "strong" mark is also not established based on the record before us.

mark for the same or closely related goods. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

Daniel V. Holan testified that he was aware of no instances of actual confusion. The record shows that the majority of applicant's sales are in the state of Ohio, whereas opposer is located in New Jersey. Although both parties have used their marks for several years, the absence of actual confusion is not surprising given the disparate geographic markets. Moreover, we are mindful that the test is likelihood of confusion, not actual confusion. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

Finally, although we harbor no doubt in this case, it is well settled that any doubt on the question of likelihood of confusion must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Accordingly, because of the similarity of the parties' marks; the relatedness of the parties' goods; the similarity of the trade channels and purchasers; and the variety of goods on which opposer has registered its mark, we find that there is a likelihood that the purchasing public would be confused when applicant uses ORLANDO and design as a mark for its goods.

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Decision: The opposition is sustained, and registration to applicant is refused.

R. L. Simms

B. A. Chapman

L. K. McLeod
Administrative Trademark Judges,
Trademark Trial and Appeal Board